

HT-03-008



Application no. 10/696,431

May 26, 2006

TO: Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Art Unit 2627 - Examiner: Tianjie chen

FROM: George O. Saile, Reg. No. 19,572  
28 Davis Avenue  
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 10/696,431  
File Date: 10/29/03  
Inventor: C.C. Han et al.  
Examiner: Tianjie Chen  
Art Unit: 2627  
Title: TWO-PIECE MAGNETIC SHIELD HAVING IMPROVED HEAT  
DISSIPATION

### RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated 05/10/06. In that office action, restriction was required to one of the following Inventions under 35 U.S.C. 121:

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on May 30, 2006.

Signature   
Stephen B. Ackerman, Reg. No. 37,761

Date: 5/30/06

The inventions stated are:

I – Claims 1-18 drawn to a method/process for improving heat dissipation in a magnetic shield, classified in class 29, subclass 603.14, and

II – Claims 19-35, drawn to a magnetic shield having good heat dissipation, classified in class 360, subclass 110.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I – Claims 1-18 drawn to a process classified in Class 29, subclass 603.14. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a "method to improve heat dissipation in a magnetic shield", and that the product claims are directed to "a magnetic shield having good heat dissipation ", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the


product and vice versa. The field of search must necessarily cover both the process class/subclass 29/603.14 and product class/subclass 360/110, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "In the instant case, the magnetic shield disclosed in Group II can be made without the particular steps disclosed in Group I, such as 'patterning' or 'planarizing'," is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of second and third patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,

  
Stephen B. Ackerman, Reg. No. 37,761